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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 10011919-1									
I hereby certify that this correspondence is being deposited in the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Patents, Alexandria, VA 22313-1450 on <u>March 31, 2006</u> Signature <u><i>Matthew B. McNutt</i></u> Typed or printed name <u>Matthew B. McNutt</u>	Application Number 09/905,623	Filed July 13, 2001									
	First Named Inventor Stuart D. Asawaka										
	Art Unit 2876	Examiner Kumiko Koyama									
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td><u><i>Matthew B. McNutt</i></u> Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td><u>Matthew B. McNutt</u> Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. 39,766 Registration number</td><td><u>612-767-2510</u> Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</td><td><u>March 31, 2006</u> Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	<u><i>Matthew B. McNutt</i></u> Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>Matthew B. McNutt</u> Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. 39,766 Registration number	<u>612-767-2510</u> Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34	<u>March 31, 2006</u> Date
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<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Stuart D. Asawaka

Examiner: Kumiko Koyama

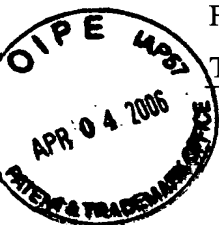
Serial No.: 09/905,623

Group Art Unit: 2876

Filed: 7/13/2001

Docket No.: 10011919-1

Title: PRINT FOR PAY PRINTER



**COMMENTS ACCOMPANYING
REQUEST FOR PRE-APPEAL BRIEF REVIEW**

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir/Madam:

Please consider the following remarks during the Pre-Appeal Brief Conference:

REMARKS

Claims 1, 3, 4, 9-12, 15 and 19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Robinson et al. (U.S. Patent No. 5,850,584). Dependent claims 2, 5-8, 13, 14, 16-18 and 20 stand rejected under a variety of 35 U.S.C. § 103(a) rejections, each of which rely on Robinson et al. as the primary reference.

Independent claim 1 is directed to a method of operating a printer. The method comprises: providing a printer including a plurality of printer operational resources, **said printer operational resources comprising *core* printer operational resources and *enhanced* printer operational resources**; receiving a resource request at said printer, said resource request including a request for at least one of use and a right of use of a selected at least one enhanced printer operational resource; operating said printer according to said resource request including at least one of use of and right of use of said selected at least one enhanced printer operational resource; and initiating a payment transaction based on said operating step, **wherein said payment transaction includes a charge calculated as a function of said *enhanced* printer operational resource request.**

Independent claim 9 is directed to a printing system. The printing system comprises: printer control including a plurality of printer operational resources supporting operation of a printer, said plurality of **printer operational resources comprising a *first* resource set and a *second* resource set**; print job control receiving a request relative to at least one of said plurality of printer operational resources; and transaction control detecting said request and

Comments Accompanying Request for Pre-Appeal Brief Review

Applicant: Stuart D. Asakawa et al.

Serial No.: 09/905,623

Filed: 7/13/2001

Docket No.: 10011919-1/H301.426.101

Title: PRINT FOR PAY PRINTER

initiating a payment transaction for said request when said at least one of said plurality of printer operational resources is a member of said *second* set, wherein said payment transaction includes a charge calculated as a function of said resource request.

Independent claims 19 is directed to a method of printer operation, **the printer having *core* printer operational resources and *enhanced* printer operational resources.** The method comprises: requesting a print job, said print job including use of a selected enhanced printer operational resource; printing at a printer said print job including use of said selected enhanced printer operational resource; and executing a payment transaction in favor of a resource vendor as a function of said print job, **wherein said payment transaction includes a charge calculated as a function of said *enhanced* printer operational resource request.**

As set forth above, independent claims 1 and 19 specify that the printer operational resources comprise **core** printer operational resources and **enhanced** printer operational resources, and that the payment transaction includes a charge calculated as a function of said **enhanced** printer operational resource request. Independent claim 9 similarly divides printer operational resources into a first resource set (e.g., a core resource set) and a second resource set (e.g., an enhanced resource set), and initiates a payment transaction when the requested printer operational resource is a member of said second set, wherein the payment transaction includes a charge calculated as a function of the resource request.

Contrary to the characterization of the reference set forth in the Office Action, Applicants respectfully submit that Robinson et al. fails to teach, or suggest each and every feature of independent claims 1, 9 and 19. In particular, Applicants submit **Robinson et al. fails to distinguish between core printer operational resources and enhanced printer operational resources, and fails to teach or suggest a charge calculated as a function of the request for the use or right of use of an “enhanced printer operational resource,” as opposed to a charge for the printed product generally.**

Robinson et al. teaches that the user selects an image of a desired quality, and costs are then calculated based on the amount of materials consumed for that job (col. 6, lines 34-36), the paper used for the job (col. 7, lines 47-49), and the type of finishing coating (col. 7, lines 62-67). Various methods for determining the amount of materials consumed are described (col. 6, line 42 through col. 7, line 46). **However, in Robinson et al., there is not**

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a division or distinction between core operational resources and enhanced operational resources, and the cost is not calculated as a function of an enhanced operational resource request. As seen by the cost curve set forth in Figure 2 of Robinson et al., costs fall along a continuous curve, without a cost distinction between core and enhanced operational resources. Thus, even if Robinson et al. is interpreted as having both core and enhanced operational resources (for example, black and white output vs. color output), the cost in Robinson et al. is calculated as a function of *all* operational resource requests (i.e., both core and enhanced resources), not just those resource requests utilizing what may be characterized as “enhanced” operational resources.

In the Final Office Action mailed February 10, 2006, the Examiner alleges that Applicants do not specifically claim the differences between core printer operational resources and enhanced operational resources, and further alleges that the claims do not recite what is included in each of the core printer operational resources and the enhanced printer operational resources. (Final Office Action, para. 9). However, Applicants respectfully submit that the differences between core resources and enhanced resources are clearly set out in the specification. The application describes dividing printer resources into layers to stratify price levels, and states, “A core layer 70 contains the basic printer resourced needed to print standard output, e.g., frequently used resources, *for which there is no fee.*” (Page 6, lines 29-31, emphasis added). Exemplary core resources are listed, including nominal throughput, nominal quality level, nominal ink level sensor, and nominal resolution. (Page 6, lines 31-33). The application further states, “A first layer 72 contains additional or enhanced resources relative to the core layer 70 resources.” (Page 7, lines 1-2). Exemplary enhanced resources are listed, including faster throughput, premium quality level, enhanced ink level sensor, and better resolution. (Page 7, lines 2-7). Thus, the differences between core resources and enhanced resources are clearly understood from the definitions set forth in the application.

The Examiner further alleges that although the cost in Robinson et al. includes standard features, the cost is still calculated as a function of enhanced printer operational resources because the cost also depends on special materials used. The Examiner further states that the claims recite that the charge is calculated as a function of enhanced printer operational resources, but do not recite that the charge eliminates the charge of core printer

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Serial No.: 09/905,623

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Docket No.: 10011919-1/H301.426.101

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operational resources. However, as noted above, the application clearly states that core resources are those frequently used resources *for which there is no fee.*" (Page 6, lines 29-31). Thus, it is clear that the charge calculation does not include charges for core resources, as by definition there is no fee for core resources.

For at least the reasons set forth above, Robinson et al. fails to anticipate the subject matter of independent claims 1, 9 and 19. Accordingly, withdrawal of the rejection of independent claims 1, 9 and 19 under 35 U.S.C. § 102(b) is respectfully requested.

Each of dependent claims 2-8, 10-18 and 20 depend, either directly or indirectly, from one of independent claims 1, 9 and 19, which are in allowable condition for at least the reasons set forth above. Therefore, the dependent claims are also in allowable condition at least by reason of their dependency from an allowable independent claim. Accordingly, withdrawal of the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) is respectfully requested.

Comments Accompanying Request for Pre-Appeal Brief Review

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Docket No.: 10011919-1/H301.426.101

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Conclusion

In view of the above, Applicant respectfully submits that pending claims 1-20 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-20 is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (280) 396-3958, or Matthew B. McNutt at Telephone No. (612) 767-2510, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Respectfully submitted,

Stuart D. Asakawa

By their attorneys,

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Date: March 31, 2006

MBM:imv

A handwritten signature of Matthew B. McNutt in black ink.

Matthew B. McNutt

Reg. No. 39,766

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31st day of March, 2006.

By

Name: Matthew B. McNutt